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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,700	09/02/2004	Tobias Hintermann	BS/1-22632/CGM/ 527/PCT	4707
324 7590 04/17/2007 CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005			EXAMINER VALENROD, YEVGENY	
			ART UNIT 1621	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/17/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/506,700

Applicant(s)

HINTERMANN ET AL.

Examiner

Yevgeny Valenrod

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 and 16 is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-14, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/03/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Nesvabda et al. (WO 00/07981, published 2/17/2000). Claims 19 and 20 are product-by-process claims:

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from the product of the prior art, the claim is unpatentable even though the prior art product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (MPEP § 2113).

Examples B12 – B13 on page 35, describe polymerization of n-butylacrylate. In each case poly-n-butylacrylate is obtained as the polymer product. The same product is obtainable by a process according to the instant claim 9 or instant claim 14.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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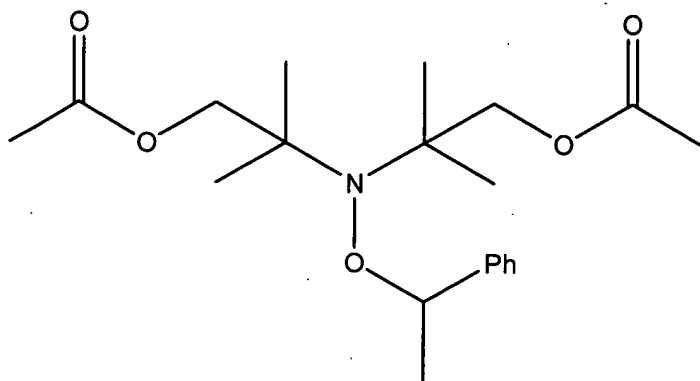
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 5 and 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nesvabda et al. (WO 00/07981).

Scope of prior art

Nesvabda et al. teach compound **213** on page 30:



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The above compound corresponds to the compound of the instant invention as follows:

R1, R2, R3 and R4 are all methyl.

R5, and R6 are both H.

Y = O

X = -CHCH₃-aryl

R7 and R8 are both C(O)CH₃.

Nesvabda et al also teach:

- A polymerizable composition that comprises the compound(s) of their invention and at least one ethylenically unsaturated monomer or oligomer (page 17 second to last paragraph). Limitation of claim 8 and 13.
- A process for preparing an oligomer by free radical polymerization of at least one ethylenically unsaturated monomer, which comprises polymerizing the monomer in the presence of at least one initiator. (page 12 paragraph 6). Limitation of claims 9 and 14.
- A polymerization process wherein the scission of O-X bond is effected by ultrasonic treatment or heating, wherein if heating the temperature is between 50 and 160°C. (page 12 paragraphs 7 and 8, also examples B12 – B14 on page 35 where heat is used). Limitation of claims 10 and 11.
- Initiator compound is preferably present in an amount of from 0.1 mol-% to 20 mol-%. (Page 12 paragraph 5). Limitation of claim 12.

Ascertaining the difference between prior art and the instant claims

Structure 213 above defines R4 as methyl. However, the instant claims limit R4 to 2-12 alkyl.

Obviousness

Compound 213 differs from a similar compound of the instant invention where R4 is ethyl by one CH₂ group. Such a difference defines the two compounds as homologues. One of ordinary skill in the art would expect homologous compounds to vary only slightly in the chemical and physical characteristics. Members of homologous series must possess unexpected properties not possessed by the homologous compounds disclosed in the prior art. In re Hass 141 F.2d 127, 60 USPQ 548 (CCPA 1944). In the instant case, the difference of one methylene group is not expected to significantly alter the physical and chemical properties. Applicant is invited to provide evidence of unexpected results in the polymerization process arising from the use of the claimed homologue of Nesvabdas' compound **213**, wherein in one of the methyl groups in the alpha position to the nitrogen is replaced with an ethyl.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims

are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 8-11, 13-14 and 19-29 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 7, 14-18 of U.S. Patent No. 6,518,326 ('326). Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds, processes and the

polymer of the instant invention are claimed in '326 with enough similarity to render the instant invention obvious.

The claims correspond as follows: (Instant claims / '326 claims)

1-5 / 1-3; 8 / 7; 9 / 14; 10 / 15; 11 / 16; 13 / 18; 14 / 19; 19-20 / 17.

Ascertaining the difference

Claims of '326 differ from the claims of the instant application in that the '326 claims are directed to compounds 1b and 1c, of which only 1b teaches the instant compound. Also, although the substitution of compound 1b as defined by claim 1 of '326 allows for overlapping with the instantly claimed compounds of formula 1a, not all of the compounds of formula 1a are covered by the claim.

Obviousness

The two inventions have enough overlapping subject matter to meet the obviousness requirement. When R5 and R6 are both Hydrogens in Compound 1a of the instant application, the compound is taught by claim 1 of '326.

Claim objections

Claims 6 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 6 and 7 are directed to compounds of formula 1b or 1c. The closest reference Nesvabda et al. (WO 00/07981) teaches the compound of formula 1a where the R1 – R4 are alkyl groups. In the compounds of claims 6 and 7 at least one of R1 – R4 is a phenyl group. Substituting alkyl for a phenyl

group is neither disclosed nor suggested in the closest art. One of ordinary skill in the art would not be motivated to make such a modification.

Allowable subject matter

Claims 15 and 16 are allowed. The closest reference Nesvabda et al. (WO 00/07981) teaches the compound of formula 1a where the R1 – R4 are alkyl groups. In the compounds of claims 6 and 7 at least one of R1 –R4 is a phenyl group. Substituting alkyl for a phenyl group is neither disclosed nor suggested in the closest art. One of ordinary skill in the art would not be motivated to make such a modification.

Conclusion

Claims 1-16 and 19-20 are pending

Claims 1-5, 8-14 and 19-20 are rejected

Claims 6 and 7 are objected to

Claims 15 and 16 are allowed

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yevgeny Valenrod whose telephone number is 571-272-9049. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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